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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/883,178	06/19/2001	Wendy Naimark	12013/58201	9892

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KENYON & KENYON LLP  
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SUITE 700  
WASHINGTON, DC 20005

EXAMINER
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MACNEILL, ELIZABETH

ART UNIT	PAPER NUMBER
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3767

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/16/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

**Office Action Summary**

Application No.

09/883,178

Applicant(s)

NAIMARK ET AL.

Examiner

Elizabeth R. MacNeill

Art Unit

3767

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 17 November 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 13-18 and 24-27 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 13-18 and 24-27 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 June 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Allowable Subject Matter*

1. The indicated allowability of claims 13-18 and 24-27 is withdrawn in view of the newly discovered reference(s) to Naftulin et al (US 2,901,112); Swank (US 3,965,896); and Schneller (US 3,592,245). Rejections based on the newly cited reference(s) follow.

### *Claim Rejections - 35 USC § 102*

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 13,14,16-18, and 27 are rejected under 35 U.S.C. 102(b) as being anticipated by Naftulin et al.

Regarding claims 13 and 18, Naftulin teaches a device with a first lumen (A), a second lumen (B), an exit orifice (at B'), a mixing chamber (10) within the first lumen, having a passageway (interior of 10) with a permeable membrane (filter 10). As seen in figure 2, the first and second lumens are concentric.

Regarding claim 14, there is a third lumen (C)

Regarding claim 16, membrane is adapted to extract a solvent (certain particles are stopped and trapped by the filter)

Regarding claim 17, the fluid delivered by the device is a therapeutic.

Regarding claim 27, the mixing chamber is capable of being placed inside a patient.

4. Claims 13, 15-18 and 27 are rejected under 35 U.S.C. 102(b) as being anticipated by Swank.

Regarding claims 13 and 18, Naftulin teaches a device with a first lumen (26), a second lumen (24), an exit orifice (at 58), a mixing chamber (40) within the first lumen, having a passageway (at 44) with a permeable membrane (resin filter 40). As seen in figure 2, the first and second lumens are concentric.

Regarding claim 15, there is a vacuum source (via tube 46) and resin within the second lumen (part of resins 40)

Regarding claim 16, membrane is adapted to extract a solvent (certain particles are stopped and trapped by the filter)

Regarding claim 17, the fluid delivered by the device is a therapeutic.

Regarding claim 27, the mixing chamber is capable of being placed inside a patient.

5. Claims 13, 16-18 and 27 are rejected under 35 U.S.C. 102(b) as being anticipated by Schneller (US 3,592,245).

Regarding claims 13 and 18, Schneller teaches a device with a first lumen (inside 10), a second lumen (inside 58), an exit orifice (in 42), a mixing chamber (42) within the first lumen, having a passageway (42) with a permeable membrane (16). As seen in figure 2, the first and second lumens are concentric.

Regarding claim 16, membrane is adapted to extract a solvent (certain particles are stopped and trapped by the filter)

Regarding claim 17, the fluid delivered by the device is a therapeutic.

Regarding claim 27, the mixing chamber is capable of being placed inside a patient.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 24-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Naftulin et al.

Naftulin et al teaches the disclosed invention except for using a metal for the first lumen (claim 24); using a polycarbonate for the filter (claim 25); using glass microfibers for the filter (claim 26). It would have been obvious to one of ordinary skill in the art at the time the invention was made to use a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin* 125 USPQ 416. It is well known in the art to use polycarbonates or glass microfibers as filter material; it is also well known to use metal as a lumen material in medical devices.

8. Claims 24-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Swank.

Swank teaches the disclosed invention except for using a metal for the first lumen (claim 24); using a polycarbonate for the filter (claim 25); using glass microfibers for the filter (claim 26). It would have been obvious to one of ordinary skill in the art at the time the invention was made to use a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin* 125 USPQ 416. It is

well known in the art to use polycarbonates or glass microfibers as filter material; it is also well known to use metal as a lumen material in medical devices.

9. Claims 24-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schneller.

Schneller teaches the disclosed invention except for using a metal for the first lumen (claim 24); using a polycarbonate for the filter (claim 25); using glass microfibers for the filter (claim 26). It would have been obvious to one of ordinary skill in the art at the time the invention was made to use a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin* 125 USPQ 416. It is well known in the art to use polycarbonates or glass microfibers as filter material; it is also well known to use metal as a lumen material in medical devices.

### ***Drawings***

10. New corrected drawings in compliance with 37 CFR 1.121(d) are required in this application because the drawings are informal and difficult to read (especially figures 5 and 7). Applicant is advised to employ the services of a competent patent draftsman outside the Office, as the U.S. Patent and Trademark Office no longer prepares new drawings. The corrected drawings are required in reply to the Office action to avoid abandonment of the application. The requirement for corrected drawings will not be held in abeyance.

**Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elizabeth R. MacNeill whose telephone number is (571)-272-9970. The examiner can normally be reached on 7:00-3:30pm M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin Sirmons can be reached on (571)272-4965. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

ERM

*Elizabeth R. MacNeill*  
11/4/07

KEVIN C. SIRMONS  
SUPERVISORY PATENT EXAMINER

*Kevin C. Sirmons*